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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,875	02/05/2002	Timothy R. Kane	END920020006US1	6282
23550	7590	09/15/2005	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			LIN, KENNY S	
75 STATE STREET			ART UNIT	
14TH FL			PAPER NUMBER	
ALBANY, NY 12207			2154	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/067,875	Applicant(s) KANE ET AL.	
	Examiner Kenny Lin	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Claims 1-21 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1, 7, 10 and 16 recite the broad recitation "one of a plurality of retrieved formats", and the claims also recites "retrieving a (one) format for transforming" as "the retrieved format" which is the narrower statement of the

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range/limitation. If the preceding step taught to retrieve only one format, how can there exist a plurality of retrieved formats?

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3, 10, 12, 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Endo, US 2004/0212841, filed on April 30, 2004 with a priority date to a divisional application filed on October 26, 1998.

6. Endo was cited in the previous office action.

7. As per claim 1, Endo taught the claimed invention including a method for routing data by a server, comprising the step of:

- a. Providing an application on the server (pp. 0048-0049, system or program is loaded from the HD drive, OS program, document-transmission control program);
- b. Providing a table of formats and protocols on the server, wherein the table is accessible by the application (pp. 0049, 0052-0053, 0055-0056, 100-105, default

data-transmission-format information base and various transmission protocols, destination list);

- c. Receiving, on the server, data to be routed from a source to a destination (pp. 0048-0049; server HD reading, loading and storing document read from a scanner for transmission), the data having the destination (e.g. receiver email address, ftp address; figs.4-8) and a transaction type (e.g. transmission methods such as email, ftp, fax; figs. 4-8) included therein (pp. 0055-0056, 0060-0065, figs.3-4, 8-9; document input unit; data are collected in accordance with data transmission format based classification and communication-method based classification);
- d. Retrieving, from the table, a format for transforming the data and a protocol for communicating the data based on the destination, the transaction type and the source (pp. 0055-0056, 0058-0059, 0061, 100-105); and
- e. The application transforming the data into the retrieved format, and routing the transformed data to the destination using the retrieved communication protocol (pp. 0055-0056, 0065-0066, 0068-0069, 0096-0097), wherein the application is adapted to transform the data in one of a plurality of received formats into the transformed data in one of a plurality of retrieved formats (pp. 0065-0066).

8. As per claims 10 and 16, Endo taught the claimed invention including a system and its program product for routing data by a server, comprising:

- a. A table system for providing a table having formats and protocols (pp. 0048-0049, 0052-0053, 0055-0056, default data-transmission-format information base and various transmission protocols, destination list);
 - b. A data reception system for receiving data from a source to be routed to a destination (pp. 0048-0049), the data having a destination and a transaction type included therein (pp. 0055-0056, 0060-0065, figs.3-4, 8-9; document input unit; data are collected in accordance with data transmission format based classification and communication-method based classification);
 - c. A retrieval system for retrieving a format for transforming the data and a protocol for communicating the protocol from the table based upon the source, the destination and the transaction type (pp. 0055-0056, 0058-0059, 0061, 100-105);
 - d. A transformation system for transforming the data into the retrieved format (pp. 0055-0056, 0065-0066); and
 - e. A routing system for routing the transformed data to the destination using the retrieved protocol (pp. 0055-0056, 0068-0069, 0096-0097), wherein the application is adapted to transform the data in one of a plurality of received formats into the transformed data in one of a plurality of retrieved formats (pp. 0065-0066).
9. As per claims 3, 12 and 18, Endo taught the invention as claimed in claims 1, 10 and 16. Endo further taught to comprise the step of identifying the source, prior to the retrieving step (pp. 0065; designate the document input source).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 4, 7, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, US 2004/0212841, in view of Olejar et al (Olejar), US 2003/0037100.

12. Olejar was cited in the previous office action.

13. As per claim 7, Endo taught the invention substantially as claimed including a method for routing data by a server, comprising the steps of:

- a. Providing a communication application on the server (pp. 0048-0049, system or program is loaded from the HD drive, document-transmission control program);
- b. Entering a table of formats, protocols, sources, destinations and transaction types on the server, wherein the table is accessible by the application (pp. 0049, 0052-0053, 0055-0056, default data-transmission-format information base and various transmission protocols, destination list);
- c. Receiving, on the server, data to be routed from an identified source to a destination (pp. 0048-0049), the data having the destination and a transaction type

included therein (pp. 0055-0056, 0060-0065, figs.3-4, 8-9; document input unit; data are collected in accordance with data transmission format based classification and communication-method based classification);

- d. Retrieving from the table a format for transforming the data and a protocol for communicating the data, based on the destination, the transaction type and the source (pp. 0055-0056, 0058-0059, 0061, 100-105); and
- e. The application transforming the data into the retrieved format, and routing the transformed data from the server to the destination using the retrieved communication protocol (pp. 0055-0056, 0065-0066, 0068-0069, 0096-0097), wherein the application is adapted to transform the data in one of a plurality of received formats into the transformed data in one of a plurality of retrieved formats (pp. 0065-0066).

14. Endo did not specifically teach to detect errors in the data based upon omissions in the data. Olejar taught to detect errors in retrieved data based upon omissions in the data (claim 4; intelligent detection means). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo and Olejar because Olejar's teaching of detecting errors enable Endo's method to detect incomplete or inaccurate data received and automatically retrieve data to correct the problem (see Olejar, claim 4).

15. As per claims 4, 13 and 19, Endo taught the invention substantially as claimed in claims 1, 10 and 16. Endo did not specifically teach the step of the application detecting errors in the

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retrieved data based upon omissions in the data. Olejar taught an application to detect errors in retrieved data based upon omissions in the data (claim 4; intelligent detection means). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo and Olejar because Olejar's teaching of detecting errors enable Endo's method to detect incomplete or inaccurate data received and automatically retrieve data to correct the problem (see Olejar, claim 4).

16. Claim 2, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, US 2004/0212841, in view of Deng, US 6,243,394.

17. Deng was cited in the previous office action.

18. As per claims 2, 11 and 17, Endo taught the invention substantially as claimed in claims 1, 10 and 16. Endo further taught that the provided table further includes sources, destinations and transaction type (figs.5-7; pp. 0055). Endo further taught to designate a document input source (pp. 0065). Endo did not specifically teach to include sources in the table. Deng taught to include sources in the table (col.5, lines 34-38, col.8, lines 44-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Endo and Deng and include sources to the table to inform the data receiver where the data is from.

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19. Claim 5, 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, US 2004/0212841, in view of Lakshman et al (Lakshman), US 6,078,564.

20. Lakshman was cited in the previous office action.

21. As per claims 5, 14 and 20, Endo taught the invention substantially as claimed in claims 1, 10 and 16. Endo did not specifically teach the step of tracking data communication between the source and the destination. Lakshman taught to track data communication between the source and the destination (col.4, lines 64-67, col.5, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo and Lakshman because Lakshman's teaching of tracking communication enables Endo's method to monitor the transmission of the data transmitted in the communication path.

22. Claim 6, 15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, US 2004/0212841, in view of Harris, Jr. et al (Harris), US 6,144,975.

23. Harris was cited in the previous office action.

24. As per claims 6, 15 and 21, Endo taught the invention substantially as claimed in claims 1, 10 and 16. Endo did not specifically teach further the step of generating a report based upon data communications and detected errors. Harris taught to generate a report based upon data communication and detected errors destination (col.1, lines 35-36, col.8, lines 54-67, col.9, lines

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1-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo and Harris because Harris' teaching of reporting enable Endo's method to present the users or the administer a documentary of the errors.

25. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo and Olejar as applied to claim 7 above, and further in view of Lakshman et al (Lakshman), US 6,078,564.

26. As per claim 8, Endo and Olejar taught the invention substantially as claimed in claim 7. Endo and Olejar did not specifically teach the step of tracking data communication between the source and the destination. Lakshman taught to track data communication between the source and the destination (col.4, lines 64-67, col.5, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo, Olejar and Lakshman because Lakshman's teaching of tracking communication enables Endo and Olejar's method to monitor the transmission of the data transmitted in the communication path.

27. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Endo, Olejar and Lakshman as applied to claim 8 above, and further in view of in view of Harris, Jr. et al (Harris), US 6,144,975.

28. As per claim 9, Endo, Olejar and Lakshman taught the invention substantially as claimed in claim 8. Endo, Olejar and Lakshman did not specifically teach further the step of generating a

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report based upon data communications and detected errors. Harris taught to generate a report based upon data communication and detected errors destination (col.1, lines 35-36, col.8, lines 54-67, col.9, lines 1-11). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Endo, Olejar, Lakshman and Harris because Harris, Olejar and Lakshman's teaching of reporting enable Endo's method to present the users or the administer a documentary of the errors.

29. Applicant's arguments filed 8/10/2005 have been fully considered but they are not persuasive.

30. In the remark, applicant argued on the newly added features introduced in the amendment that (1) Endo fails to teach "receiving, on the server, data to be routed from a source to a destination, the data having the destination and a transaction type included therein." (2) Endo fails to teach that "the application is adapted to transform the data in one of a plurality of received formats into the transformed data in one of a plurality of retrieved formats."

31. Examiner traverse the argument:

As to points (1) and (2), examiner has cited paragraphs and provide explanations to show that Endo specifically teaches the newly added features including a data reception system for receiving data from a source to be routed to a destination (pp. 0048-0049), the data having a destination and a transaction type included therein (pp. 0055-0056, 0060-0065, figs.3-4, 8-9; document input unit; data are collected in accordance with data transmission format based

classification and communication-method based classification) and that the application is adapted to transform the data in one of a plurality of received formats into the transformed data in one of a plurality of retrieved formats (pp. 0065-0066).

Conclusion

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Farrell et al, US 5,377,191.

33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

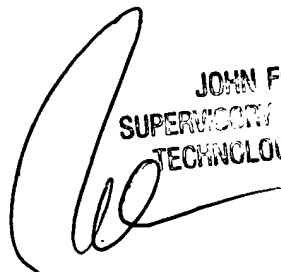
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34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (571) 272-3968. The examiner can normally be reached on 8 AM to 5 PM Tue.-Fri. and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ksl
September 8, 2005


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